

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HORST ABRAMOWSKI
and
JAMES D. WELLS

Appeal No. 1998-1671
Application No. 08/481,186

ON BRIEF

Before WARREN, LIEBERMAN, and JEFFREY T. SMITH, Administrative Patent Judges.
LIEBERMAN, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Pursuant to the provisions of 37 CFR § 1.197(b)(1997), appellants have submitted a timely Request for Rehearing (hereafter "Request") of our Decision dated July 19, 2001, affirming the following rejections under 35 U.S.C. § 103: Claims 1, 3 through 6, 8 through 13, 15, 16, 22 through 27 and 29 as being unpatentable over Albanese.

Appellants' request rehearing as the Decision based on Albanese constitutes a new ground of rejection. See Request, page 1. In this respect "appellants respectfully request

that the rejection based on Albanese and thus the Decision on Appeal be vacated.”

(Request, page 6). In addition, the appellants raise the issue as to whether the limitation, “a non-flammable solvent consisting essentially of tetrachloroethylene” (claim 1), precludes the presence of water (Request, page 6). The appellants have argued that Albanese contains preparations which include approximately 10 to 75% water (Request, page 7). They state, “[b]ecause Albanese’s aerosol formulations include water, Albanese does not disclose or suggest a non-flammable solvent consisting essentially of tetrachloroethylene as recited in the claims,” (Request, page 6). We disagree.

Our interpretation of the scope of the aforesaid limitation present in claim 1 permits the presence of water in addition to a “non-flammable solvent consisting essentially of tetrachloroethylene.” One of our principal concerns in our decision was directed to the scope of claim 1 which is illustrated below:

1. A non-flammable liquid surface-penetrating lubricant, which comprises:
 - (a) a natural or synthetic oil in an amount of up to about 28% by weight of said lubricant;
 - (b) a fluorocarbon polymer in an amount of up to about 1.8% of said lubricant;
and
 - (c) a non-flammable solvent consisting essentially of tetrachloroethylene;said lubricant being contained in a dispenser container and including a non-flammable aerosol propellant;
- whereby said lubricant packaged in said container meets non-flammability

requirements specifying that an aerosol product contain less than 50% flammable propellant and less than 25% flammable constituents in the base product.

The claims, in the record before us, require a solvent “consisting essentially of tetrachloroethylene.” At the same time however, the claimed subject matter contains the transitional language “comprises,” in describing the non-flammable liquid as a whole. As discussed in our Decision, the term “comprises” permits the inclusion of other components such as water. See Decision, page 5. Appellants, in their request, treat the presence of water as falling within the context and scope of the term “solvent.” Hence, they argue that the solvent does not consist essentially of tetrachloroethylene. (Request, page 6). We disagree. A solvent is something that dissolves or can dissolve. It is the dissolving medium. To the extent that water is present in the claimed subject matter, there is no reason to believe that water functions as a solvent for component (a) an oil or component (b) a fluorocarbon polymer which is hydrophobic or tetrachloroethylene, to the extent that each component is present.

In our view, the transitional language, “comprises” permits the presence of an additional component such as water. Furthermore, any water present does not function as a solvent within the purview of component (c) of claim 1 of the claimed subject matter. Indeed, Albanese is in accord with this interpretation since the system of his invention embodies, “generally immiscible phases, one of which may be considered a water phase, and the other an active ingredient phase.” See column 2, line 67 to column 3, line 1.

Therefore, to the extent that components (a) or (b) are present, the additional presence of water in Albanese does not come within the purview of being a solvent for these components since water does not function as a solvent for oil, i.e., water and oil do not mix. Neither does water function as a solvent for fluorocarbon polymers which are hydrophobic. Accordingly, water is not a solvent for any of components (a), (b), or (c).

Finally, even if water were to come within the scope of component (c), the transitional language "consisting essentially of" would not preclude the presence of water as a solvent, it being well-settled that the term "consisting essentially of" includes not only what is specifically recited in appellants' claim, but also any other materials which do not materially affect the basic and novel characteristics of the claimed composition. See PPG Indus., Inc. v. Guardian Indus. Corp., 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998); In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976); In re De Lajarte, 337 F.2d 870, 873-74, 143 USPQ 256, 258 (CCPA 1964); In re Janakirama-Rao, 317 F.2d 951, 954, 137 USPQ 893, 896 (CCPA 1963). Based upon the disclosure and teachings of Albanese the presence of water does not materially affect the composition.

As for the request by the appellants that, "the Decision on Appeal be vacated and a new decision by [sic, be] issued based on the combination of the references cited by the examiner," be entered, Request, page 6, we have neither reversed nor vacated the decision

of the examiner based on Runge in view of Albanese. Rather, our decision has focused on the vast scope of the claimed subject matter before us, and we have concluded based thereupon that even the secondary reference to Albanese is sufficient in and of itself to establish a prima facie case of obviousness with respect to the claimed subject matter. Accordingly, we affirmed the decision of the examiner.

Finally, the appellants argue that In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976), limiting the discussion to the evidence contained in Albanese while using the same basis and teachings as the examiner relied upon does not constitute a new ground of rejection. See Kronig, 539 F.2d at 1303, 190 USPQ at 427; In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961), relied upon by the Board is inappropriate. We disagree. The findings made by this merits panel were essentially the same as those made by the examiner. See Answer, page 4, last two lines, page 5, second and third paragraphs, and page 6, lines 1-6. In affirming the decision of the examiner, we have relied upon essentially the same factual findings made by the examiner in the Answer. The examiner recognized that Albanese was directed to a water containing composition as did this merits panel. We relied on the same evidence and findings made by the examiner. The sole distinction is that we focused on the water containing composition of Albanese and recognized that in all other respects Albanese was closer to the claimed subject matter disclosing each of the requisite components for the

same purpose. Moreover, we recognized that the claim did not preclude the presence of a water containing composition. As such, we concluded that the basic thrust of the rejection by the examiner and the Board was the same and appellants have had fair opportunity to react to the water containing composition of Albanese.

As to the balance of appellants' arguments, each of them has previously been addressed in our Decision and we do not find in the Request any argument convincing us of error in the conclusions we reached in our Decision.

Accordingly, appellants' Request for Rehearing is denied.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

CHARLES F. WARREN
Administrative Patent Judge

PAUL LIEBERMAN
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

)
)
)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)

Appeal No. 1998-1671
Application No. 08/481,186

8

PL:hh

Appeal No. 1998-1671
Application No. 08/481,186

9

STEPHEN M. BODENHEIMER, JR.
BELL, SELTZER, PARK & GIBSON
P.O. DRAWER 34009
CHARLOTTE, NC 28234